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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91202948
Party	Plaintiff David A. Kay and Christopher N. Cramer
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DAVID A. KAY AND)	
CHRISTOPHER N. CRAMER)	
)	Opposition No. 91202948
Opposers,)	
)	Mark: MAXIMIST
v.)	
)	Application Serial No. 85/225,969
APOLLO SPRAYERS)	
INTERNATIONAL, INC.)	
)	
Applicant.)	

OPPOSERS' MOTION FOR JUDGMENT ON THE PLEADINGS

Opposers, David A. Kay and Christopher N. Cramer, by and through their attorneys, Leydig, Voit & Mayer, Ltd., hereby move for judgment on the pleadings in their favor, pursuant to Fed. R. Civ. P. 12(c) and TBMP § 504. Applicant Apollo Sprayers, Inc. ("Apollo") has admitted the salient allegations in Opposers' Notice of Opposition, and there is no genuine issue of material fact to be resolved. Judgment on the pleadings is thus appropriate in this case.

I. The Pleadings are Closed and Opposers' Claim is Ripe for Judgment

The Rules of Civil Procedure provide for the entry of judgment on the pleadings when a party pleads facts undercutting and precluding its claims or defenses. *See* Fed. R. Civ. P. 12(c). This serves the purpose of judicial economy, avoiding an unnecessary trial where additional evidence could not reasonably be expected to change the result. The pleadings in this case closed on January 18, 2012, when Apollo filed its Answer to the Notice of Opposition.

Judgment on the pleadings should be granted when the moving party establishes that no material issue of fact remains to be resolved in light of the pleadings and that the moving party is entitled to judgment as a matter of law. *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992). Even if, as required, the Board deems all of Apollo's factual allegations to be true for purposes of this motion, Apollo's Answer fails to raise any issues that, if proven, would defeat Opposers' motion. *See id.*

II. Opposers are Entitled to Judgment as a Matter of Law on the Issue of Likelihood of Confusion

To prevail on the issue of likelihood of confusion, Opposers must show (1) prior valid trademark rights and (2) that Apollo's mark is likely to cause confusion, mistake, or deception as to the source of Apollo's goods. 15 U.S.C. § 1052(d). A likelihood of confusion is a question of law to be determined by the Board if there are no disputed facts. *In re Majestic Distilling Co.*, 65 USPQ2d 1201,1203 (Fed. Cir. 2003); *Blansett Pharmacal Co., Inc. v. Carmrick Laboratories, Inc.*, 25 USPQ2d 1473, 1476-77 (TTAB 1992).

The Notice of Opposition and Apollo's Answer establish likelihood of confusion as a matter of law:

Notice of Opposition at Paragraph 9: Upon information and belief, Applicant has been aware of Opposer Christopher N. Cramer's use of the mark "MAXIMIST" in connection with spray tanning equipment since 2008.

Apollo's Answer at Paragraph 9: Admitted.

Notice of Opposition at Paragraph 12: Upon information and belief, Applicant has not yet commenced offering any goods or services under the mark "MAXIMIST."

Apollo's Answer at Paragraph 12: Admitted.

Notice of Opposition at Paragraph 13: Opposers' use of the mark "MAXIMIST" has been valid and continuous since the date of first use and has not been abandoned. Opposers' mark is symbolic of extensive goodwill and consumer recognition built up by Opposers through substantial amounts of time and effort in advertising and promotion. In view of the fact that the parties' respective marks are identical and the goods covered by their respective trademark applications are identical and/or closely related and overlapping, it is alleged that Applicant's mark so resembles Opposers' mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive.

Apollo's Answer at Paragraph 13: **Applicant admits that the parties' respective marks are identical, that the goods covered by the marks are closely related and that they would likely cause confusion in the marketplace.** Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 13 of the Notice of Opposition. Since Applicant can neither admit nor deny the remaining allegations as written, Applicant must deny them.

Since Apollo has admitted that (1) Opposers have priority of use of the mark "MAXIMIST" and (2) that the parties' marks are identical, that the goods covered by the marks are closely related, and that this would cause a likelihood of confusion, judgment on the pleadings is appropriate.¹

III. Apollo's Affirmative Defenses Must Fail

While an applicant may plead defenses, including affirmative defenses, that it may have to the claims asserted by an opposer, Apollo's four affirmative defenses are insufficient to overcome its admissions, and should be summarily denied. *See* 37 CFR § 2.106(b)(1).

A. First and Second Affirmative Defenses

As its first affirmative defense at Paragraph 18 of its Answer, Apollo claims that "Opposers lack standing to pursue this Opposition." As its second affirmative defense at

¹ Apollo filed its trademark application for "MAXIMIST" based on intent-to-use on January 25, 2011, roughly three years later than Opposers' actual first use date for the "MAXIMIST" mark, as pleaded in the Notice of Opposition and admitted in Apollo's Answer.

Paragraph 19, Apollo claims that “Opposers [sic] Notice of Opposition fails to state a claim upon which relief can be granted.” These are frequently used and pleaded affirmative defenses, but typically fail to support a party’s defense of an action. In this case, Opposers’ pleaded facts and Apollo’s admissions speak for themselves.

Opposers need only include (1) a short and plain statement of why they believe they would be damaged by the registration of Apollo’s mark (i.e. standing) and (2) a short and plain statement of one or more grounds. 37 CFR § 2.104(a). All that is necessary is to provide Apollo a fair notice of the basis of Opposers’ claim. *See* TBMP § 309.03(a)(2). With respect to standing, all that is required at the pleading stage is that Opposers allege facts sufficient to show a “real interest” in the proceeding and a “reasonable basis” for their belief of damage”. TBMP § 309.03(b). Opposers’ allegations of priority and a likelihood of confusion in their Notice of Opposition meet these criteria. *See Id.*, and cases cited therein.

Additionally, “Likelihood of confusion is a ground for opposition to trademark or service mark registration.” *Opryland USA Inc. v. The Great American Music Show Inc.*, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992); *see* TBMP § 309.03(c). Opposers have a direct and personal stake in the outcome of the opposition, which is grounded on likelihood of confusion, due to their prior use of and pending application for the mark “MAXIMIST” in connection with closely related goods. Opposers have met the statutory requirement of pleading standing and a ground for opposition, and are not required to plead any further facts to meet their burden at this early stage of the proceeding. Moreover, as a practical matter, Apollo cannot on the one hand admit the salient allegations in the Notice of

Opposition and on the other deny that Opposers have pleaded such allegations. Apollo's first two affirmative defenses, therefore, fail as a matter of law.

B. Third Affirmative Defense

As its third affirmative defense at Paragraph 20, Apollo pleads that "Opposers are not entitled to relief because Applicant's Application predates the application of the Opposers." Yet it is precisely because Apollo has filed a prior pending application that Opposers have filed this action. As pleaded in their Notice of Opposition, Opposers' later-filed application, Serial No. 85/317,895, was issued an Office Action, which cited Apollo's subject mark as a potential bar to registration under Section 2(d) of the Lanham Act. Opposers claim priority of use of the mark at issue in connection with closely related or identical goods, and the existence of a likelihood of confusion. At its core this is the *raison d'être* of the opposition system. As stated in TBMP § 309.03(b), "A real interest in the proceeding and a reasonable belief of damage may be found, for example, where plaintiff pleads . . . [that it] has been advised that it will be refused registration when defendant's application matures into a registration." Apollo's third affirmative defense also fails.

C. Fourth Affirmative Defense

Apollo's fourth affirmative defense (Paragraph 21) purports to invoke the "family of marks" doctrine, by alleging rights to various "MIST"-formative marks in the spray tanning equipment industry. In its simplest form, a family of marks is a group of marks having a recognizable common feature that is used in such a manner as to be recognized by the consuming public as a source identifier. *See J & J Snack Foods Corp. v. McDonald's Corp.*, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991). While this doctrine

applies if the party in the position of plaintiff asserts that it has established a family of marks prior to defendant's first use of a challenged mark, for a defendant in an inter partes proceeding under Section 2(d), the issue is whether it can prove priority of use of the mark **which is the subject of the proceeding**, not whether it can prove priority of use of some other mark or marks. *Blansett Pharmacal*, 25 USPQ2d at 1477; see *Baroid Drilling Fluids*, 24 USPQ2d 1048.

Baroid Drilling is on point and particularly instructive here. In *Baroid*, the petitioner filed a petition to cancel respondent's registration for the mark ENVIRO-SPOT under Section 2(d) based on prior use of the identical mark in connection with identical goods. As Apollo has done here, the respondent in *Baroid* admitted that the respective marks were identical and that the goods were closely related or identical. The respondent in *Baroid* also admitted that the petitioner had priority of use of the mark. However, in its affirmative defenses, the respondent pleaded that since before petitioner's alleged first use of its mark, the respondent had created a family of marks comprising the prefix "enviro-" for similar goods and services, and that respondent owned various registrations for such marks. As such, the respondent claimed that it had prior rights in the mark ENVIRO-SPOT by virtue of its "enviro-" family of marks. The petitioner filed a motion for judgment on the pleadings, and the Board granted same. In rejecting the "family of marks" defense, the Board held that "the priority-of-use issue under Section 2(d) . . . is whether the defendant's use of its mark sought to be registered . . . precedes the plaintiff's use of plaintiff's pleaded mark(s), not whether the defendant has priority of use of another mark or marks which the plaintiff's mark(s) so resembles as to be likely to cause confusion." *Baroid Drilling Fluids*, 24 USPQ2d at 1053. "The fact that

respondent may own other registered marks, including a family of marks, is irrelevant.”
Id.; see also, *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1736-37 (TTAB 2001) (in entering summary judgment for opposer, the Board held that it was well settled that a family of marks argument can be used offensively as a sword by the opposer, but not defensively as a shield by the applicant). Apollo’s fourth affirmative defense, therefore, fails to establish that it is entitled to judgment.

IV. Conclusion: Judgment Should be Granted in Opposers’ Favor as a Matter of Law

The issue for the Board to determine in an opposition proceeding is the right of an applicant to register the mark depicted in the application for the goods or services identified therein. *Octocom Systems Inc. v. Houston Computer Services Inc.*, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Opposers have pleaded, and Apollo has admitted, priority and likelihood of confusion. There is no question that Opposers have standing to bring this action and have alleged valid grounds for opposing Apollo’s subject mark. No material issue of fact remains to be resolved and judgment to Opposers should be granted as a matter of law.

Respectfully submitted,



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CERTIFICATE OF FILING AND SERVICE

This Motion for Judgment on the Pleadings is being filed electronically through the ESTTA system. The Commissioner is authorized to charge payment of any fees associated with this filing to Deposit Account No. 12-1216. Opposers' Motion for Judgment on the Pleadings is being served by first-class mail, postage prepaid on Applicant's counsel of record, as follows:

H. Daniel Fuller
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Dated: February 21, 2012
